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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,569	03/17/2004	Scott Seamans	040130-050011US	5965

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EXAMINER

MOHANDESI, JILA M

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/803,569

Applicant(s)

SEAMANS, SCOTT

Examiner

Jila M Mohandesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2004 & 10 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>28/04, 11/10/04, 01/31/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant withdrew claims 1-13 from further consideration in paper filed March 07, 2005.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 14-17 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Aguerre (6,237,250). Aguerre '250 discloses a piece of footwear comprising: a sole; an upper portion extending from the sole, wherein the upper portion is adapted to cover the top of a user's foot, and wherein the upper portion includes a rear opening for receiving the user's foot; at least one connector (inside rear buckle 156 and outside rear buckle 164) coupled to the upper portion; a strap operably coupled to the upper portion, wherein the strap is configured to be positioned across the rear opening to engage the back of the user's foot; at least one adjustment mechanism (strip with hook and loop fastener 186) that is interactable with the connector and the strap to adjust the position of the strap relative to the back of the user's foot. See Figure 1 embodiment.

4. Claims 14-17, 19 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Girard (6,860,035). Girard '035 discloses a piece of footwear comprising: a sole; an upper portion extending from the sole, wherein the upper portion is adapted to cover the top of a user's foot, and wherein the upper portion includes a rear opening for receiving the user's foot; at least one connector (guide 27) coupled to the upper portion; a strap operably coupled to the upper portion, wherein the strap (26) is configured to be positioned across the rear opening to engage the back of the user's foot; at least one adjustment mechanism (strip 26b with hook and loop fastener) that is interactable with the connector and the strap to adjust the position of the strap relative to the back of the user's foot. See Figure 1 embodiment.

Claim Rejections - 35 USC § 103

5. Claims 18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aguerre '250. With respect to claim 18 whether the coupling arrangement is hook and loop or snaps or any other art recognized equivalent is an obvious matter of choice, such as to require less manual dexterity to operate.

With respect to claim 22, Aguerre '250 discloses that the footwear can be made of rubber and plastic cushioning material, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the material of the footwear, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

6. Claims 18, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Girard '035. With respect to claim 18 whether the coupling arrangement is hook and loop or snaps or any other art recognized equivalent is an obvious matter of choice, such as to require less manual dexterity to operate.

With respect to claim 20, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a pair of connectors and adjustment mechanism to the footwear of Girard '035, since it has been held that mere duplication and rearranging of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8 and *In re Einstein*, 8 USPQ 167.

With respect to claim 22, Girard '035 discloses that the footwear can be made of plastic material, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the material of the footwear, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are footwear analogous to applicant's instant invention.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JILA M. MOHANDESI
PRIMARY EXAMINER



Jila M Mohandesi
Primary Examiner
Art Unit 3728

JMM
May 05, 2005